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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,129	04/24/2001	Scott Lee Wellington	5659-06800/EBM	5749

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EXAMINER

JOHNSON, JERRY D

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/841,129	Applicant(s) WELLINGTON ET AL.	
	Examiner Jerry D. Johnson	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4281-4302 and 5150-5159 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 4281-4302 and 5150-5159 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 17 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/30/05</u> | 6) <input type="checkbox"/> Other: _____ |

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 4281-4302 and 5150-5159 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Terry.

Terry, U.S. Patent 4,099,567, teaches a product produced from a coal formation comprising cracked gases of pyrolysis. The product reasonably appears to be either the same as or an obvious variation of the instantly claimed product because the product of Terry is also produced from a coal formation and in a similar way as compared to the claimed product. See column 2, lines 54-68 and column 5, lines 38-44 of Terry.

In the event any difference can be shown for the product of claims 4281-4302 and 5150-5159, as opposed to the product taught by Terry, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4281-4302 and 5150-5159 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

To the extent it could be argued that the claimed composition is novel or unobvious, the claimed subject matter has not been described in the specification in such a way as to enable one

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skilled in the art to make and/or use the invention, i.e., coal formations differ in chemical composition and applicants have not identified the chemical characteristics of the coal formation from which the claimed product is derived.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 4281-4302 and 5150-5159 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4369-4402 of copending Application No. 09/841,240. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims appears to be drawn to products that have the same components in overlapping amounts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the claims in 09/841,240 to obtain the product of the present application by choosing component amounts with the claimed ranges.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 4281-4302 and 5150-5159 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4429-4448 and

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5396-5405 of copending Application No. 09/841,636. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims appears to be drawn to products that have the same components in overlapping amounts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the claims in 09/841,636 to obtain the product of the present application by choosing component amounts within the claimed ranges.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 4281-4302 and 5150-5159 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4188-4284 of copending Application No. 09/841,310. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims appears to be drawn to products that have the same components in overlapping amounts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the claims in 09/841,310 to obtain the product of the present application by choosing component amounts within the claimed ranges.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed March 17, 2005 have been fully considered but they are not persuasive.

Applicants, arguing "it is not obvious to one of ordinary skill in the art that products obtained from a coal formation heated with a flame front would be the same as or an obvious

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variation of the claimed product” (Remarks, pages 10 and 11), request “the Examiner provide a basis for the statement that “the product appears to be either the same as or an obvious variation of the instantly claimed product”” (Remarks, page 13).

Terry, like applicants, teaches a product produced from a coal formation comprising cracked gases of pyrolysis wherein said product is produced by heating said coal formation. One having ordinary skill in the art would expect the product obtained from heating a coal formation to be the same regardless of whether the formation was heated with a flame or a heater. Accordingly, the product of Terry reasonably appears to be either the same as or an obvious variation of the instantly claimed product.

Applicants argue that “suitable hydrocarbon formations are described at least from line 26 of page 41 through line 29 of page 45 of the Specification.” (Remarks, page 13).

Applicants’ argument lacks merit.

Coal formations differ in chemical composition and it would be expected that any fluid obtained from a coal formation would depend on that chemical composition. Thus, to the extent it can be argued that the claimed compositions are novel or unobvious, the claimed subject matter has not been described in the specification in such a way as to enable one skilled in the art to make and/or use the invention, i.e., applicants have not identified the chemical characteristics of the coal formation from which the claimed product is derived. As to pages 41 through 45 of the specification, those pages contain a general description on which a coal formation may be selected (e.g., “richness, thickness and depth”), but fail to teach or disclose the chemical composition of the coal formation required to produce the claimed compositions.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (571) 272-1448. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Jerry D. Johnson". The signature is fluid and cursive, with a large initial "J" and "H".

Jerry D. Johnson
Primary Examiner
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jdj